



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,391	12/30/1999	CARLOS A. SILVA JR.	06975/048001	6275
26171	7590	03/13/2006	EXAMINER	
FISH & RICHARDSON P.C.			SHINGLES, KRISTIE D	
P.O. BOX 1022			ART UNIT	
MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	

2141

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/475,391	Applicant(s) SILVA ET AL.	
	Examiner Kristie Shingles	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-74 and 81-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-74 and 81-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amended claims 1, 47 and 68.

Claims 81-84 are newly added. Claims 1-35 and 75-80 have been cancelled.

Claims 36-74 and 81-84 are pending.

Allowable Subject Matter

1. After further search and consideration, new prior art has been found that is pertinent to Applicant's pending claims. The reasons for allowance given in the previous action on 6/03/2005 are hereby withdrawn. Upon further consideration, a new ground of rejection is made in view of *Kihara et al* (US 2002/0010742) and *Schultheiss et al* (US 6,545,722).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 36-39, 43-50, 52-55, 68, 70-74 and 81-84** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kihara et al* (US 2002/0010742) in view of *Schultheiss et al* (US 6,545,722).

Regarding claims 36 and 47, *Kihara et al* teach a method and a computer program disposed on a computer readable medium for providing a buddy list to a network user, the method comprising:

- accessing two or more user-defined lists of other users for whom presence is monitored, wherein each of the user-defined list comprises one or more buddy groups defined by the network user, and each of the buddy groups comprises one or more members defined by the network user (Figures 2, 3 and 7, paragraphs 0033-0034, 0043-0045, 0100-0103, 00111, 0116-0119: user is able to access lists of users, wherein the lists groups users according to user-defined classifications);
- selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming, each of the two or more user-defined lists comprising members defined by the network user, the members comprising one or more of the other users (Figures 2, 4 and 7, paragraphs 0033-0034, 0043-0045, 0100-0103, 00111, 0116-0119); and
- displaying the selected initial buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the selected initial buddy list (Figure 2, paragraphs 0101, 0111, 0116-0119).

Yet, *Kihara et al* fail to explicitly teach determining television programming selected for viewing by a network user and selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming. However, *Schultheiss et al* teach determining television programs selected for viewing by a network user and selecting a chat room from among other channel-related chat rooms, based upon the determined television program (Figure 31, col.15 lines 3-24).

It would have been obvious to one of ordinary skill in the art to combine the teachings of *Kihara et al* with *Schultheiss et al* in order to enable television-program based chatting wherein user's buddy lists are based on television programs; because just as a user may choose to chat in a particular chat room where those present are discussing a particular program,

Art Unit: 2141

the user may also want to instant message a user from a pre-defined buddy list of users who care to discuss that particular program as well; therefore allowing the user to instant message those that are currently online for immediate discussion of the selected television program.

Claims 68 and 81-84 comprise limitations that are substantially equivalent to claims 36 and 47 are therefore rejected under the same basis.

Regarding claims 37 and 48, *Kihara et al* and *Schultheiss et al* teach the method and computer program of claims 36 and 47, *Schultheiss et al* further teach wherein determining television programming comprises determining a television network (Figure 31).

Regarding claims 38 and 49, *Kihara et al* and *Schultheiss et al* teach the method and computer program of claims 36 and 47, wherein determining television programming comprises determining a television show (Figure 31, col.15 lines 3-24).

Regarding claims 39 and 50, *Kihara et al* and *Schultheiss et al* teach the method and computer program of claims 36 and 47, wherein determining television programming comprises determining a characteristic of a television show (Figure 31).

Regarding claims 43 and 52, *Kihara et al* and *Schultheiss et al* teach the method of claim 36 and 47, *Schultheiss et al* further teach the method and computer program further comprising receiving information indicating a change in the television programming viewed by the network user; selecting a different chat room based upon the changed television programming (Figure 31, col.15 lines 16-24).

Regarding claims 44 and 53, *Kihara et al* and *Schultheiss et al* teach the method of claim 36 and 47, *Kihara et al* further teach wherein the different buddy list differs from the initial buddy list (Figure 2 and 7, paragraph 0102).

Regarding claims 45 and 54, *Kihara et al* and *Schultheiss et al* teach the method of claim 36 and 47, *Kihara et al* further teach wherein at least one member of the different buddy list differs from the members of the initial buddy list (Figure 2 and 7, paragraph 0102).

Regarding claims 46 and 55, *Kihara et al* and *Schultheiss et al* teach the method of claim 36 and 47, *Kihara et al* further teach wherein the members of the different buddy list differs from the members of the initial buddy list (Figure 2 and 7, paragraph 0102).

Claims 70-74 are substantially equivalent to claims 43-46 and are therefore rejected under the same basis.

4. **Claims 40-42 and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kihara et al* (US 2002/0010742) and *Schultheiss et al* (US 6,545,722) in view of *Schindler* (US 6,081,830).

Regarding claims 40 and 51, *Kihara et al* and *Schultheiss et al* teach the method and computer program products of claims 39 and 50 as applied above, yet fail to explicitly teach wherein determining a characteristic comprises determining a type of the television show. However, *Schindler* teaches determination of the type of television show by implementing electronic program guides which are commonly used to display information about television shows, including the type of show, actors, brief summary of program, etc. (col.1 lines 23-29, col.3 line 60-col.4 line 17, col.5 lines 3-28).

It would have been obvious to one of ordinary skill in the art to combine the teachings of *Kihara et al* and *Schultheiss et al* with *Schindler* in order to enable user to determine the type of television show they are watching in accordance to other characteristics of the

Art Unit: 2141

television show. Television electronic program guides are well-known and commonly used in the art in order to provide and display this service to the user.

Regarding claim 41, *Schindler* further teaches the method of claim 40 wherein the type comprises sports (col.1 lines 23-29).

Regarding 42, *Schindler* teaches the method of claim 41 wherein determining television programming comprises determining a sports team (col.1 lines 23-29, col.5 lines 3-28).

5. **Claims 56-67 and 69** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kihara et al* (US 2002/0010742) and *Schultheiss et al* (US 6,545,722) in view of *Aravamudan et al* (US 6,301,09).

Regarding claim 56, 62 and 69, *Kihara et al* and *Schultheiss et al* teach the method and computer program product of claims 36, 47, and 68 as applied above; yet fail to explicitly teach receiving user definition of a first buddy list and a second buddy list. However, *Aravamudan et al* teach further the method and computer program product further comprising receiving user definition of a first buddy list and a second buddy list (abstract, col.1 lines 39-49, col.2 lines 33-36, col.6 lines 22-27, col.9 lines 50-52, col.11 lines 15-18). Therefore it would have been obvious to one of ordinary skill in the art combine the teachings of *Kihara et al* and *Schultheiss et al* with *Aravamudan et al* for receiving user definition of a first buddy list and a second buddy list, because allowing the user to define other users added to their buddy list enables users to make preferences in who they want to communicate with over instant messaging, further allowing the user to instant message those that are currently online for immediate private discussion of the new television program the user has switched to.

Regarding claims 57 and 63, *Aravamudan et al* teach the method and computer program of claims 56 and 62, wherein selecting an initial buddy list comprises selecting an initial buddy list from among the first buddy list and the second buddy list (abstract, col.1 lines 39-49, col.2 lines 33-36, col.6 lines 22-27, col.9 lines 50-52, col.11 lines 15-18).

Claims 58 and 64 are substantially equivalent to claims 43-46 and are therefore rejected under the same basis.

Claims 59 and 65 are substantially equivalent to claim 43 and are therefore rejected under the same basis.

Claims 60 and 66 are substantially equivalent to claim 43 and are therefore rejected under the same basis.

Claims 61 and 67 are substantially equivalent to claim 45 and are therefore rejected under the same basis.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Stautner et al* (US 6,600,503), *Kohda et al* (US 6,751,656), *Zenith* (US 6,519,771).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

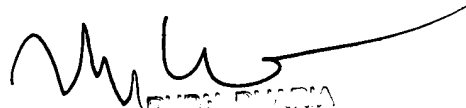
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds



KRISTIE SHINGLES
EXAMINER
ART UNIT 2141